

REMARKS

New claims 29-61 are pending. Claims 29-61 are directed to a process of substantially preventing the formation of at least one nitrosamine in a harvested tobacco plant. Support for the claims is found throughout the specification, *e.g.*, page 10, line 16 to page 11, line 2; page 20, line 8 to page 21, line 8, and in grandparent application Serial No. 08/998,043 (which is incorporated by reference in its entirety) at page 10, lines 6-16. No new matter has been added.

In accordance with the claimed invention, following the claimed drying step, the plant portion has a content of at least one tobacco-specific nitrosamine selected from N'-nitrosonornicotine, 4-(N-nitrosomethylamino)-1-(3-pyridyl)-1-butanone, N'-nitrosoanatabine, and N'-nitrosoanabasine which at least 75% by weight lower than the content of that nitrosamine in cured brown tobacco made from the same tobacco crop but which was cured in the absence of steps designed to reduce the content of said at least one nitrosamine.

It is respectfully submitted that the claimed comparison of nitrosamine content to that in conventionally cured tobacco is properly definite. As discussed in grandparent application Serial No. 08/998,043, nitrosamine content in tobacco treated in accordance with the invention can be compared to a control, *e.g.*, tobacco from the same crop which was cured by conventional techniques. *See, among many others*, Example 13 (pp. 60-61 of '043 application) in which Samples 108 and 109 are controls ("leaf samples having undergone the normal flue curing process") to which Samples 110 and 111 (convection-treated) are compared.

Dr. Burton's declaration, originally submitted in application Serial No. 08/998,043 (copy attached), states at ¶ 18 that describing nitrosamine content in tobacco by comparison to tobacco which was cured by conventional techniques is well-understood by those skilled in the art. As an example of this type of comparison being used in the prior art, Chamberlain, *Studies on the Reduction of Nitrosamines in Tobacco*, Tobacco International, (1986) Vol. 188, No. 16, pp. 38-39 (of record), reports at the bottom of page 38 that spraying ascorbic acid solution on certain harvested leaves was found to yield "[a]fter flue curing, a 76% reduction in the amount of NNN, compared to untreated leaves."

Moreover, the Federal Circuit has held that "[s]ection 112, ¶ 2, requires only reasonable precision in delineating the bounds of the claimed invention." *United States v. Teletronics*, 857 F.2d 778, 786, 8 USPQ2d 1217 (Fed. Cir. 1988) (emphasis added). In *Modine Mfg. Co. v. United*

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States Int'l Trade Comm'n, 75 F.3d 1545, 37 USPQ2d 1609 (Fed. Cir.), *cert. denied*, 518 U.S. 1005 (1996), the Federal Circuit explained “[m]athematical precision should not be imposed for its own sake; a patentee has the right to claim the invention in terms that would be understood by persons of skill in the field of the invention.” *Ibid*, 75 F.3d at 1557 (emphasis added).

The Board of Patent Appeals and Interferences, in recently reversing a rejection under 35 U.S.C. § 112 ¶ 2, also observed that the second paragraph “requires claims to set out and circumscribe a particular [area] with a reasonable degree of precision and particularity.” *Ex parte Bivens*, 53 USPQ2d 1045, 1046 (Bd. Pat. App. & Int. 1999) (citing *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977)). The Board found that it was not apparent, nor did the Examiner “cogently explain[],” why this standard was not met. *Bivens*, 53 USPQ2d at 1046.

In claims 29-61 above, the comparison in nitrosamine content which is used to define the invention is one which not only is understood by persons skilled in the art, but also is used in the art, as shown by Chamberlain. Claims 29-61 therefore define the invention with at least “reasonable precision,” *Telectronics*, 857 F.2d at 786, and “in terms that would be understood by persons of skill,” *Modine*, 75 F.3d at 1557. Accordingly, it is respectfully submitted that claims 29-61 satisfy the definiteness requirement of 35 U.S.C. § 112 ¶ 2.

CONCLUSION

It is submitted that claims 29-61 are properly definite and are in condition for allowance. Early examination of the subject application is respectfully requested.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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By: Susan A. Wolfe
Susan A. Wolfe
Registration No. 33,568

Eleventh Floor
1001 G Street, N.W.
Washington, DC 20001-4597
(202) 508-9100